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PEPPER HAMILTON LLP ONE MELLON CENTER, 50TH FLOOR 500 GRANT STREET PITTSBURGH, PA 15219			LEE, SEUNG H	
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Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

<b>Office Action Summary</b>	<b>Application No.</b> 10/826,092	<b>Applicant(s)</b> SHENKER ET AL.	
	<b>Examiner</b> Seung H. Lee	<b>Art Unit</b> 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 41-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 and 44-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/01/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of Group I in the reply filed on 11 February 2005 is acknowledged.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3-6, 14, 23, 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor (US 5,578,808).

Re claim 1: Taylor teaches a method for managing multi-application data card using with a card reader (not shown) wherein the card reader serves as a electronic device and the method comprising storing multiple applications such as American Express, Visa, Master Charge, Discovery, various other application as shown in figure 1 wherein the stored multiple application are initially disabled in which the multiple application serves as data transfer application, identifying (45 and 146) of user by verifying the PIN entered by user wherein such identifying user serves as identifying multiple applications registered to the particular user of the card, presenting (47 and 152) stored multiple applications for user's selection wherein such presenting of the

Art Unit: 2876

stored multiple application serves as displaying an identifier of the multiple applications that user can select accordingly and selecting particular applications to be executed, authorizing the transaction of particular transaction (54 and 198) when the authentication (196) of the user is successful wherein such authorizing the transaction of the transaction serves as enabling the data transfer application for use by the user, exiting selected application after completing requested transaction (e.g., adding charging to the account balance, etc.) wherein the exiting selected application serves as disabling the application

Re claims 3 and 4: Taylor teaches that each application of the data card having containing PIN number or a second authentication code wherein stored PIN number is compared with the PIN number or first authentication code entered by users (45 and 146).

Re claims 5 and 6: Taylor also teaches to verify the user for granting of executing particular application using the biometric signature (196) such as a voice print as suggested for verifying user of the card (46).

Re claim 14: Taylor teaches the data card storing a plurality of applications such as American Express, Visa, Master Charge, Discovery, etc. wherein American Express, Visa, Master Charge, Discovery, other various applications names serves as a user0specified nickname for presenting particular application, that is, each and every application name is associating/representing actual application information such as account numbers.

Re claim 23: Taylor teaches to select another application (168) after completion of a transaction using selected application (200) in which serves as disabling selected application following completion of processing by the enabled application (see Figs. 6-8; col. 6, line 62-col. 8, line 9).

Re claim 24: Taylor teaches to select another application (168) after completion of a transfer funds (218) that is initiated user (see Figs. 6-8; col. 8, lines 10-39).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor in view of Sukeda et al. (US 6,659,345)(hereinafter referred to as 'Sukeda').

The teachings of Taylor have been discussed above.

Although, Taylor teaches the card reader for accessing the data card having a plurality of application stored therein for conducting various transactions, he fails to particularly teach or fairly suggest that the authentication mechanism operated independent of the application stored in the smart card.

However, Sukeda teaches a smart card (110) comprising a processor for rights to play (213) for authenticating the right of play (222 and 222') for executing application

Art Unit: 2876

or module independently (see Figs. 4, 9-11; col. 10, lines 23- 63; col. 13, line 17- col. 16, line 42).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Sukeda to the teachings of Taylor in order to provide a centralized authenticating system by controlling the plurality of application using single authentication module for authenticating the user's rights to play or execute particular application in which such centralized controlling system generally provide an maintenance friendly system.

6. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor in view of Beatson et al. (US 5,892,824)(hereinafter referred to as 'Beatson').

The teachings of Taylor have been discussed above.

Although, Taylor teaches the data card comprising a plurality of application stored therein for conducting various transactions using authentication means, he fails to particularly teach or fairly suggest that the user signature is compared with signature stored in the card associated with the data transfer application.

However, Beatson teaches that user is authenticated by comparing signature information stored in the smart card (66) with signature information captured when the user signed the receipt during transaction electronically (see Figs. 2 and 6; col. 8, line 65- col. 9, line 28).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Beatson to the teachings of Taylor

Art Unit: 2876

in order to provide an improved security by comparing the lave captured signature with signature information stored in the smart card for preventing unauthorized use of the card.

7. Claims 9, 10, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor in view of Teicher et al. (US 6,257,486)(hereinafter referred to as 'Teicher').

The teachings of Taylor have been discussed above.

Although, Taylor teaches the data card comprising a plurality of application stored therein for conducting various transactions using authentication means, he fails to particularly teach or fairly suggest that the user can attempt authentication up to a predetermined number of times.

However, Teicher teaches a smart card PIN system wherein user is challenged to enter the PIN number within predetermined number of times or predetermined time period for accessing smart card (see fig. 6; col. 5, line 59- col. 7, line 53).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings (i.e., allowing the user to provide PIN number up to a predetermined number of time) of Teicher to the teachings (i.e., authorizing to execute particular application) of Taylor in order to provide an improved security by limiting attempt to access the stored data in the card in case of lost of data card then unauthorized access of the data card is attempted.

Art Unit: 2876

8. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor in view of Allen et al. (US 6,776,332)(hereinafter referred to as 'Allen').

The teachings of Taylor have been discussed above.

Although, Taylor teaches the data card comprising a plurality of application stored therein for conducting various transactions using authentication means, he fails to particularly teach or fairly suggest that the method comprising displaying of an identifier for representing one application thereon.

However, Allen teaches a smart card (102) comprising a LCD device (212) for displaying information thereon and a scroll keys (240 and 236) for navigating the text on the display (see Fig. 2; col. 4, line 66- col. 5, line 25).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Allen to the teachings of Taylor in order to provide a user-friendly system for displaying one identifier such as a name of application on the display of the smart card wherein the user can scroll down/up to verify/select the proper application registered to the particular users among list of applications available to the user for various transactions such as a credit card transaction using particular credit card.

9. Claims 11-13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor in view of Ishii et al. (US 5,541,985)(hereinafter referred to as 'Ishii').

The teachings of Taylor have been discussed above.



Although, Taylor teaches the card reader for accessing the data card having a plurality of application stored therein for conducting various transactions using authentication means, he fails to particularly teach or fairly suggest that a mobile device is a cellular phone and transmitting first transaction information and receiving second transaction information to/from a second device.

However, Ishii teaches a cellular phone (10) comprising an IC card reader/writer (16) for receiving an IC card (22), and transmitting personal authorization number serving as a first transaction information to a host computer of the credit company (S19') wherein the host computer serves as a second device and receiving a return code (S23') or receiving the second transaction information from the host computer, and transmitting and receiving transaction information can be conducted using an antenna (14) or using the wireless interface (see figs. 2 -10; col. 2, line 60- col. 3, line 26; col. 5, line 25-col. 8, line 28).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Ishii to the teachings of Taylor in order to provide a convenience to a user(s) wherein the user(s) wish to conduct various transaction such as credit card transaction using the application stored in the IC card as taught by Taylor in addition to communicate with other users using the cellular phone as taught by Ishii.

10. Claims 18, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor.

The teachings of Taylor have been discussed above.

Although, Taylor teaches the card reader for accessing the data card having a plurality of application stored therein for conducting various transactions, he fails to particularly teach or fairly suggest that the authentication mechanism operated independent of the application stored in the smart card and registering of data application for use by the user or a service provider.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to realize that a plurality of application stored in the data card can be installed or registered by the user, service provider, and/or provider of the electronic device, that is, the user can install or register an application as shown in figure 4 such as a prepaid card account to the data card by user, a service provider of the application such as credit company (e.g., AMEX, VISA, etc.) can install or register the application to the data card, and/or the retail store or a provider of the portable card reader for conducting transactions such purchasing the goods and services can install or register the account number for the user to the card reader.

11. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor in view of Kraft (US 6,411,822).

The teachings of Taylor have been discussed above.

Although, Taylor teaches the card reader for accessing the data card having a plurality of application registered by the user, he fails to particularly teach that the user

Art Unit: 2876

is prompted to enter the identifier for the application and stored the identifier in the mobile device.

However, Kraft teaches a mobile device or a phone (1) for receiving a SIM card (16) having a plurality of records wherein each record can be identified by the user according to name and/or number as shown in figure 3, and the entire records of the SIM card is copied into the RAM memory of the phone (see Figs. 1-4; col. 3, line 51- col. 6, line 18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Kraft to the teachings of Taylor in order to provide faster executing or accessing of the user selected application stored in the data card by copying applications including an authentication data such as the PIN number associated with application stored in the card into the memory of the phone wherein each and every application can be identified by associated unique identification such as a name or a number entered during registering of each and every records by the user.

12. Claims 26, 28- 31, and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor in view of Ishii.

The teachings of Taylor have been discussed above.

Although, Taylor teaches the card reader for accessing the data card having a plurality of application stored therein for conducting various transactions using

Art Unit: 2876

authentication means, he fails to particularly teach or fairly suggest that a mobile device is a cellular phone.

The teachings of Ishii have been discussed above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Ishii to the teachings of Taylor in order to provide a convenience to a user(s) wherein the user(s) wish to conduct various transaction such as credit transaction using the application stored in the IC card as taught by Taylor in addition to communicate with other users using the cellular phone as taught by Ishii.

13. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor as modified by Ishii as applied to claim 26 above, and further in view of Sukeda.

The teachings of Taylor/Ishii have been discussed above.

Although, Taylor/Ishii teaches the card reader for accessing the data card having a plurality of application stored therein for conducting various transactions, they fails to particularly teach or fairly suggest that the authentication mechanism operated independent of the application stored in the smart card.

The teachings of Sukeda have been discussed above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Sukeda to the teachings of Taylor/Ishii in order to provide a centralized authenticating system by controlling the plurality of application using single authentication module for authenticating the user's

rights to play or execute particular application in which such centralized controlling system generally provide an maintenance friendly system.

14. Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor as modified by Ishii as applied to claim 26 above, and further in view of Beatson.

The teachings of Taylor/Ishii have been discussed above.

Although, Taylor/Ishii teaches the data card comprising a plurality of application stored therein for conducting various transactions using authentication means, they fails to particularly teach or fairly suggest that the user signature is compared with signature stored in the card associated with the data transfer application.

The teachings of Taylor/Ishii have been discussed above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Beatson to the teachings of Taylor/Ishii in order to provide an improved security by comparing the lave captured signature with signature information stored in the smart card for preventing unauthorized use of the card.

15. Claims 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor as modified by Ishii as applied to claim 26 above, and further in view of Teicher.

The teachings of Taylor/Ishii have been discussed above.

Art Unit: 2876

Although, Taylor/Ishii teaches the data card comprising a plurality of application stored therein for conducting various transactions using authentication means, they fails to particularly teach or fairly suggest that the user can attempt authentication up to a predetermined number of times.

The teachings of Teicher have been discussed above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings (i.e., allowing the user to provide PIN number up to a predetermined number of time) of Teicher to the teachings (i.e., authorizing to execute particular application) of Taylor/Ishii in order to provide an improved security by limiting attempt to access the stored data in the card in case of lost of data card then unauthorized access of the data card is attempted.

16. Claims 44, 46-49, 52, 53, and 55- 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor in view of Kraft.

The teachings of Taylor have been discussed above.

Although, Taylor teaches the card reader for accessing the data card having a plurality of application registered by the user, he fails to particularly teach the component of the electronic device.

The teachings of Kraft have been discussed above.

In addition to the teachings of Kraft as discussed above, he also teaches that the mobile phone (1) for receiving the SIM card (16) further comprises a processor or

Art Unit: 2876

controller (18), a display (3), an keyboard (2) serving as an input device connected to the processor, a transmitter/receiver circuit (19) serving as a communication interface connected to the processor, memories such as RAM (17) and a flash ROM (17b) serving as a computer-readable storage medium connected to the processor for storing program or operating software (not shown) for operating the mobile phone including accessing of information stored in the SIM card wherein the credit transaction includes a exchange of data such as receiving approval or denial data in response to transaction requests using the particular credit accounts (see figs. 1-2; col. 3, line 51- col. 4, line 58).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to realize that the components (e.g., a processor, a memory storing operating program, a display, and an input device, etc.) as taught by Kraft must be presented in the mobile phone device in order to properly operating the mobile phone wherein the operating the mobile phone using the aforementioned components includes credit transaction using the particular application stored in the data card as taught by Taylor.

17. Claims 45 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor as modified by Kraft as applied to claims 44 and 52 above, and further in view of Sukeda.

The teachings of Taylor/Kraft have been discussed above.

Although, Taylor/Kraft teaches the card reader for accessing the data card having a plurality of application stored therein for conducting various transactions, they fails to particularly teach or fairly suggest that the authentication mechanism operated independent of the application stored in the smart card.

The teachings of Sueda have been discussed above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Sueda to the teachings of Taylor/Kraft in order to provide a centralized authenticating system by controlling the plurality of application using single authentication module for authenticating the user's rights to play or execute particular application in which such centralized controlling system generally provide an maintenance friendly system.

18. Claims 50, 51, 59, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor as modified by Kraft as applied to claims 44 and 52 above, and further in view of Beatson.

The teachings of Taylor/ Kraft have been discussed above.

Although, Taylor/Kraft teaches the data card comprising a plurality of application stored therein for conducting various transactions using authentication means, they fails to particularly teach or fairly suggest that the user signature is compared with signature stored in the card associated with the data transfer application.

The teachings of Beatson have been discussed above.



It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Beatson to the teachings of Taylor/Kraft in order to provide an improved security by comparing the lave captured signature with signature information stored in the smart card for preventing unauthorized use of the card.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jonstromer (US 6,142,369) discloses an electronic transaction terminal such as a cellular phone for conducting financial transaction using the smart card,

Chan et al. (US 6,233,683) discloses a multi-application smart card system wherein the application can be loaded after issuance of the smart card,


Rose et al. (US 5,770,843) discloses an access card for storing multiple accounts.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Seung H. Lee whose telephone number is (571) 272-2401. The examiner can normally be reached on Monday-Friday, 7:30 AM- 4:00 PM.

Art Unit: 2876

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Seung H Lee  
Art Unit 2876  
April 12, 2005